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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/614,016

07/08/2003

Marie-Laure Delacour

05725.1224-00

9511

22852

7590

06/26/2009

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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

06/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/614,016	Applicant(s) DELACOUR ET AL.	
	Examiner Lakshmi S. Channavajjala	Art Unit 1611	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-4, 8-20, 22, 25-51 and 57-63.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Lakshmi S Channavajjala/
 Primary Examiner, Art Unit 1611

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' argue that instant claims have been amended to recite 10% to 50% of pearlescent agents, which are not taught or suggested by the prior art. It is argued that the art at best teaches 0% to 20% or a preferred range of 2% or 15%. It is argued that the '862 and '345 patents do not use any pearlescent agents in their examples and the '704 patent only describes the use of 5%, which is outside the range. It is argued that the specific guidance teaches away from the claimed amounts. Applicants' arguments are not persuasive because "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). Further, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Thus, a skilled artisan would have understood from the prior art teachings that the pearlescent agents may be employed in the compositions depending on the need and up to 20%. It is also to be noted that the prior art amounts of pearlescent agents overlap with that claimed in the instant invention and MPEP states In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Applicants argue that the prior art references fail to suggest or provide guidance regarding the desirability of the claimed ratios of organopolysiloxanes and particulate phases and hence there is no reasonable expectation of success and hence no prima facie case of obviousness established. It is argued that in the '862 patent, two foundation products having different amounts of organopolysiloxane produced significantly different properties as measured by the amount of composition that was transferred onto a cloth collaret after the foundations were applied to the skin and dried in the air (Example 4, columns 9-10). Applicants also refer to the Declaration submitted by Marie-Laure Delacaour to demonstrate that the properties varies with the amounts. However, in contrast to applicant's arguments '862 also teaches a pasty, soft composition that is transfer resistant and does not dry out. Further, it is the elastomeric organopolysiloxane that renders the flexible property to the composition in '704. '704 as well as '862 teaches the same organopolysiloxane that has been tested in the declaration and also described in the instant application. While examiner notes that instant claims are not limited to a single organopolysiloxane, the argued unexpected results i.e., "pulverulent-to-pasty" finish is expected from the prior art because as explained above, all the references cited are directed to producing a soft pasty composition with the same ingredients claimed and accordingly, optimizing the amounts of organopolysiloxane and pearlescent agents with an expectation to obtain the claimed composition would have been within the scope of a skilled artisan. A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Applicants' arguments with respect to EP '930 (based on US '345 patent) are considered but not found persuasive in light of the examiner's position presented above with respect to '345. Applicants' argue that JP fails to teach particulate phase and pearlescent agents, more so because the range of pearlescent agents now claimed is different from that taught by prior art. However, the motivation to add particulate phase to JP composition comes from EP 930, with an expectation to provide modified texture and color to the composition. Thus, a skilled artisan would have expected to achieve uniform make-up with sharp contours when applied.

Applicants argue that '345 is filed earlier than the instant application and therefore a one-way test should be applied in determining if double patenting exists between instant and the patented claims. However, the rejection clearly explains how the patented claims constitute an obvious variation of the instant claims, particularly, because the patented claims include all of the claimed components and the claimed forms such as foundation (claim 58 of patent and also instant application) and also claim 38 of the patent recites different cosmetic forms that are also claimed in the instant claim 58. Instant claims now recite the amounts of pearlescent agents. While '345 does not recite pearlescent agents, the patented claims recite pigments that constitute particulate materials (fillers, nacres, pigments etc.). In the absence of any unexpected advantage, a skilled artisan would have employed any particulate pigment, including a pearlescent pigment in order to successfully prepare a powder or a solid stick etc., in the claimed composition of '345 patent. Thus, the above cosmetic forms of the patented claims provide the desirability of the instant claimed textures.